

Applicant notes that, although none of the pending claims is amended herein, all of the claims are attached as Appendix A to this Response in order to aid the Examiner in reviewing the Response.

#### Priority

The Examiner points out that the originally filed application is disclosed as a continuation of parent application Ser. No. 08/722,898, filed on September 24, 1996, but that the preliminary amendment filed on September 25, 1999 discloses that the present application is a continuation-in-part of the parent application. The Examiner requests appropriate correction. Applicant notes that the present application was transferred after filing to the attorneys of record. Applicant points out that several minor changes were made to the language of the present application (compare page 12, lines 140-144 of the present application to col. 6, lines 22-31 of the parent, U. S. Patent No. 5,764,916). While it is believed that these changes in the present application introduce no new matter, the filing of the preliminary amendment was precautionary.

#### Double patenting rejections

The Examiner rejects claims 1-70 under the judicially created doctrine of double patenting over claims 1-2 and 4-5 of U. S. Patent No. 5,764,916. The Examiner states that the subject matter claimed in the instant application is fully disclosed in and covered by the patent. Applicant respectfully traverses this rejection because the subject matter recited in the claims does not include all of the limitations of the patent and therefore is not covered by the patent.

Rejections under 35 U.S.C. § 103

Claims 1-4, 14-16, 18-21, 29-32, 46-49 and 56-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,862,223, issued to Walker, et al. (hereinafter referred to as "Walker") in view of "WebBoard builds powerful on-line forum effortlessly" (hereinafter referred to as "WebBoard"). Applicant respectfully traverses this rejection because there is no teaching, suggestion or motivation to combine these references.

Claim 1 recites:

A method for real time network communication, comprising:  
    forming a real time communications protocol connection over a  
network communications connection;  
    embedding a markup language instruction in a message; and  
    sending the message on the real time communications protocol  
connection.

The Examiner states that Walker teaches a method for real time network communication comprising forming a real time communications protocol connection, embedding text in a message and sending the message on the communications protocol connection (see Paper 8, page 5). The Examiner admits, however, that Walker does not teach that the text is a markup language instruction (see Paper 8, page 6). The Examiner states that it would have been obvious to a person of ordinary skill in the art that "incorporating WebBoard's embedded markup language instruction in Walker's message would have enhanced Walker's traditional message exchange by providing more browser-like features to the messages." The Examiner states that the motivation to make this modification to Walker would have been to "increase the effectiveness of the message exchange."

Applicant respectfully points out that in order to combine references for an obviousness rejection, there must be some teaching, suggestion or incentive supporting the combination. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q. 2d 1397, 1399 (Fed. Cir.

1989). The mere fact that the prior art could be modified does not make that modification obvious unless the prior art suggests the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, it is well established that Applicant's disclosure cannot be used to reconstruct Applicant's invention from individual pieces found in separate, isolated references. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

Walker discloses a system for establishing a synchronous communications channel between an expert and an end user (col. 26, lines 58-61). There is no motivation, teaching or suggestion in Walker to modify the system to send a message having a markup language instruction embedded therein. WebBoard discloses a system for enhancing a traditional bulletin board by allowing users to incorporate HTML tags . . . in their messages" (page 1, paragraph 5). There is no motivation, teaching or suggestion in WebBoard to combine the disclosed system with a synchronous communications channel. Applicant therefore respectfully submits that there is no motivation, teaching or suggestion to combine Walker with WebBoard. Consequently, the rejection on a combination of these references is inappropriate.

Applicant notes that all of claims 2-4, 14-16, 18-21, 29-32, 46-49 and 56-63 include limitations similar to the one described above in regard to claim 1. All of these claims are therefore patentable over the cited references for the same reasons set forth above in regard to claim 1.

Claims 5-9, 17, 22-28, 33-45, 50-55 and 64-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of WebBoard , and further in view of Reviews, Eudora Pro 3.0 (hereinafter referred to as "Eudora"). Applicant respectfully traverses this rejection because there is no teaching, suggestion or motivation to combine these references.

In regard to claim 17, the Examiner applies the combination of Walker and WebBoard essentially as applied to claims 1-4, 14-16, 18-21, 29-32, 46-49 and 56-63, but admits that Walker fails to teach that the hyperlink is associated with a URL and that the URL is passed to a Web browser. The Examiner states, however, that this limitation is taught by Eudora. (The Examiner does not contend that WebBoard remedies this deficiency of Walker.)

Eudora teaches an e-mail package. Eudora does not contain any motivation, teaching or suggestion that it should be combined with a system for establishing a synchronous communications channel between an expert and an end user (as in Walker) or with a system for enhancing a traditional bulletin board (as in WebBoard). There is therefore no motivation, teaching or suggestion to combine Eudora with either Walker or WebBoard. (Further, as explained above in regard to claims 1-4, 14-16, 18-21, 29-32, 46-49 and 56-63, there is no motivation, teaching or suggestion to combine Walker with WebBoard.) Consequently, the combination of these references is inappropriate in a rejection of any of the claims.

Additionally, in regard to claim 17, Eudora fails to teach the limitation for which the Examiner cites this reference. The system of Eudora identifies URL's in messages, colors the URL's and underlines them. The URL's are not passed to a Web browser as recited in the claim. Walker and WebBoard likewise fail to teach or suggest this limitation. Consequently, even if the references could properly be combined (which they cannot), they would fail to teach or suggest all of the limitations of claim 17. This claim would therefore be patentable over the references.

In regard to claims 5-9, 22-28, 33-45, 50-55 and 64-70, the Examiner states that Walker does not teach parsing a message to identify a hyperlink therein and displaying the message in accordance with the hyperlink, but contends that this limitation is taught by

Eudora. Applicant points out, however, that Eudora discloses that URL's, not hyperlinks, are identified (see page 2, line 12 – page 3, line 29 of the instant application regarding the distinction between URL's and hyperlinks). The URL's are automatically identified, colored and underlined (page 1, paragraph 4). It appears that the URL's which are identified in the email messages are plain text which can be underlined and colored. Eudora does not teach or suggest that the URL's are accompanied by hyperlinks in the message. Further, Eudora specifically teaches that the URL's are displayed in colored and underlined text, and not in accordance with a hyperlink which is contained in the message (see page 10 of the instant application). Accordingly, Applicant submits that the combination of references cited by the Examiner fails to disclose all the limitations of the rejected claims. Claims 5-9, 22-28, 33-45, 50-55 and 64-70 are therefore patentable over the references.

For at least the foregoing reasons, withdrawal of the rejections and allowance of all pending claims is respectfully requested.

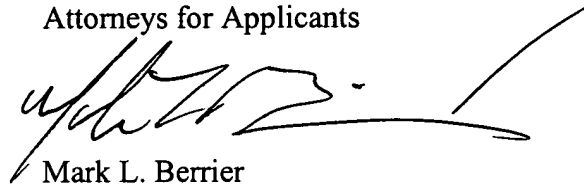
Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request full allowance of claims 1-70.

An extension of one (1) month is requested and a Petition for Extension of Time Under 37 C.F.R. § 1.136 with the appropriate fee is submitted herewith.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-0456 of Gray Cary Ware & Freidenrich, LLP.

Respectfully submitted,

GRAY CARY WARE & FREIDENRICH LLP  
Attorneys for Applicants



Mark L. Berrier  
Reg. No. 35,066

April 28, 2000

100 Congress Avenue  
Suite 1440  
Austin, TX 78701  
Tel. (512) 457-7000  
Fax. (512) 457-7070